



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,971	04/13/2000	Sarah Liljegren	19452A-000700US	7002

7590

04/30/2003

Townsend and Townsend and Crew LLP
Two Embarcadero Center
8th Fl
San Francisco, CA 94111-3834

EXAMINER

KRUSE, DAVID H.

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 04/30/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/548,971

Applicant(s)

LILJEGREN ET AL.

Examiner

David H Kruse

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires ___ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 5-7,9-18,20-28,30 and 34-40.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The proposed amendments do not overcome the rejections under 35 USC 103 for claims 5-7, 9-18 and 34-40, the rejection of claims 34-40 under 35 USC 112, first paragraph, for written description, the rejection of claims 20-28 and 30 under 35 USC 112, first paragraph, for scope of enablement, and the rejection of claims 34-40 under 35 USC 112, first paragraph for enablement. Applicant's arguments have been fully considered but are not found to be persuasive. At claims 34-40, the polynucleotide is claimed as capable of suppressing IDN1 expression to result in a plant with delayed fruit dehiscence, Applicant has failed to adequately describe such a polynucleotide including what 200 contiguous nucleotides of SEQ ID NO: 1 would be effective in what plant (claim 35). At claims 20-28 and 30, Applicant argues that the Botterman Declaration demonstrates that co-suppression of IND1 using either homologous Arabidopsis or heterologous Brassica sequences result in inhibition of fruit dehiscence, but the Examiner notes that claim 20 is not limited to Arabidopsis and the instant specification does not teach one of skill in the art how to make and use a polynucleotide encoding an IDN1 polypeptide at least about 70% identical to SEQ ID NO: 2. At claims 34-40, Applicant argues that the amount of screening to identify an inhibiting sequence is likely to be quite limited and that sequences very similar to the endogenous plant sequence would be selected and screened (page 8 of the Remarks), this is not found to be persuasive because the instant claims are directed to an expression cassette for introduction into any plant as outlined in the previous Office action. At claims 5-7, 9-18 and 34-40, Applicant argues that the teachings of Ryan would not be interpreted by one of ordinary skill in the art that the sequence played any particular role in plant development in light of the bare sequence and a reference to an unqualified homology to another protein (page 9 of the Remarks). This argument is not found to be persuasive because one of ordinary skill in the art would have recognized the inherent transcription regulation function of the sequence taught by Ryan. Applicant's argument on page 10 of the Remarks are not found to be persuasive because the rejections of enablement of claim 34 was directed to scope of enablement and claim 5 has not been rejected under enablement.

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180-1638

